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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,483	12/28/2000	Chio Arjona Alejandro Rafael	MX/JFC- 0018	5891

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09/08/2005

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,483

Applicant(s)

RAFAEL ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 27-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. The amendment filed June 17, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amended formula for the polyglycolyl urea hydantoin resin within page 7 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Despite applicants' response, it is not seen how the amended formula is representative of a polymeric structure, and applicants have failed to adequately explain how the originally filed structure and recited pathways lead to such a structure.

2. Claims 27-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has not found support for the claimed subject matter. The examiner has reviewed pages 4-7 of the specification and the original claims; however, support does not exist for several of applicants' claimed limitations. With respect to step A)a), reflux occurs at 58-63°C, not up to said temperature. With respect to step A)b), the catalyst is added per Kg of product during a 3-5 hour period, not per Kg of reactants for an unspecified period. With respect to step A)d), there is no support for "beginning at 50°C". With respect to step B)a), there is no support for reacting the diglycinate with aromatic isocyanate until solution is complete at 60°C. With respect to step B)b), there is no support for reacting the diglycinate with "metilen"

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diisocyanate solvent at a temperature of 200°C. Furthermore, there is no support for the two reactions involving two isocyanates. With respect to step B)d), as aforementioned within paragraph 1, there is no support for the claimed structure. Support has not been found for the subject matter of claim 29. Support has not been found for the subject matter of claim 33. Page 6 of the specification does not disclose that the catalyst is added up to the claimed temperature. With respect to claim 36, the specification does not disclose the claimed “aromatic” diglycinate, and a compound corresponding to formula (II) is not disclosed.

3. Claims 27 and 29-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the derivation of the urea resin from methylbromopropionate or methylchloropropionate, does not reasonably provide enablement for the derivation of the urea resin from any methylhaloester. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicants have failed to provide enablement for the use of methylhaloester other than the two aforementioned species. Applicants have provided no disclosure that would enable the skilled artisan to practice the invention with any other methylhaloester, without having to resort to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed Cir. 1988).

4. Claims 27-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 27 and 32, it is unclear what is meant by “cooling at 20°C” and “cooled at 70°C”. Is this the temperature that is cooled to or is this the temperature that cooling

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begins at? Furthermore, it is unclear what is meant by “cooling at 20°C and beginning at 50°C” (claim 27).

The language, “of a solvent as cresylic acid”, is not understood.

It is unclear what constitutes “metilen” diisocyanate.

The use of the “preferable” and “such as” language (claims 27 and 36) renders the claims indefinite, because it is unclear to what extent the preferred language modifies the less preferred language. Furthermore, with respect to claim 27, if the preferred species is not used, then it is unclear what reacts with the diglycinate.

The structure of formula I appears improper, because it does not denote a polymeric resin.

It is unclear what constitutes “substitute aromatic compound” and “substitute diphenylalkyl”.

It is unclear what is meant by “ $2 < n < 500$ ”.

Within claim 31, it is unclear what is meant by “A(h)”.

Within claim 33, step (h) lacks antecedent basis. Claim 27 does not refer to such a step.

Within claim 34, the recitation of a viscosity in the absence of a temperature condition renders the claim indefinite, because the value is essentially meaningless. Viscosities are temperature dependent.

Within claim 36, the claimed structure appears improper, and no definition has been provided for Ar₁.

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 5, 2005


RABON SERGENT
PRIMARY EXAMINER